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REMARKS

This application has been carefully reviewed in light of the Office Action dated October 30, 2006. Claims 1-8 were pending in this application at the time of the Office Action. Claim 1 is the independent claim. Claims 1 and 4 have been amended. No new matter has been added. Claims 2 and 3 have been cancelled. Favorable reconsideration is respectfully requested.

On the merits, the Office Action rejected Claims 1-8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Office Action also rejected Claim 1-2 and 4-8 under 35 U.S.C. §102(b) as being anticipated by Olding et al. (U.S. Pub. No. 2002/0145134; hereinafter "Olding"). Finally, the Office Action also rejected Claim 3 under 35 U.S.C. §103(a) as being unpatentable over Olding in view of Sakai et al. (U.S. Patent No. 5,847,322; hereinafter "Sakai"). Applicants respectfully traverse the above rejections for at least the following reasons.

In addition, the Examiner stated that the references cited in the Search Report PCT have been considered but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 C.F.R. 1.98(a)(1). Applicants have filed with this response to Office Action a proper information disclosure statement.

The Office Action rejected Claims 1-8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. More specifically, the Examiner stated that the terms "relatively high temperature" and "based on" were indefinite and that Claim 1 omitted an essential element. Applicants have amended the claims and believe the §112, second paragraph rejections to now be moot.

The Examiner rejected Claims 1-2 and 4-8 as being anticipated by Olding. But the Examiner states that "Olding does not disclose or suggest the sol-gel precursor comprises hybrid sol-gel materials based on methyltri(m)ethoxysilane, phenyltri(m)ethoxysilane, and/or diphenyldi(m)ethoxysilane" as claimed in Claim 3. *See* Office Action 30-Oct-2006, page 7. Therefore, amended Claim 1 and Claims 4-8 which depend on Claim 1 are not anticipated by Olding as Olding does not disclose, suggest, or teach every recited claim element.

In order to combine references for an obviousness rejection, there must be some teaching, suggestion or incentive supporting the combination. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989). The fact that a prior art device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In addition, it is also improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Furthermore, in order to make obvious Applicants' claimed invention, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 480 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Examiner rejected Claim 3 under 35 U.S.C. §103(a) as being unpatentable over Olding in view of Sakai. As stated above, the Examiner stated that Olding does not disclose the "sol-gel precursor comprises hybrid sol-gel materials based on methyltri(m)ethoxysilane, phenyltri(m)ethoxysilane, and/or diphenyldi(m)ethoxysilane," as recited in Claim 3, now amended Claim 1. But Olding in view of Sakai does not recite, suggest, teach, or render obvious all of the claim elements of Applicants' amended Claim 1. The Examiner has stated that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to

use sol-gel materials based on methyltri(m)ethoxysilane, phenyltri(m)ethoxysilane, and/or diphenyldi(m)ethoxysilane, as taught by Sakai." *See* Office Action 30-Oct-2006, page 7. If the Examiner is indeed relying on the general knowledge of one of ordinary skill in the art in combining Olding with Sakai, then the Examiner has failed to properly support such reliance. In instances where the general knowledge of one of ordinary skill in the art is asserted, "that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review." *See In Re Sang Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Therefore, the rejection of Claim 3 is improper and the Applicants respectfully request that the Examiner reexamine, reconsider, withdraw the rejection to and allow Claims 1 and 4-8.

Furthermore, Olding and Sakai are not related art and Sakai makes no mention of sol-gel. Sakai recites an "insulating tape or sheet comprising a polyester film layer and a polyolefin adhesive layer" for insulating wiring. *See* Sakai, Abstract. These two references are not analogous art and there would be no motivation to combine these two references.

Claims 4-8 depend from independent Claim 1 as discussed above and are therefore believed patentable for at least the same reasons. Applicants further believe the §102(b) rejections of Claims 4-8 to be moot in light of the above remarks and request their withdrawal.

In view of the foregoing amendments and remarks, Applicant respectfully submits that the currently pending claims are clearly patentably distinguishable over the cited and applied references. Accordingly, entry of this amendment, reconsideration of the rejections of the claims over the references cited, and allowance of this application is earnestly solicited.

Respectfully submitted,

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